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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,012	10/05/1999	ALBERT K. CHIN	4496	1400

7590 09/07/2005

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EXAMINER

NGUYEN, VI X

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

7/2/05

Office Action Summary	Application No.	Applicant(s)	
	09/413,012	CHIN, ALBERT K.	
	Examiner	Art Unit	
	Victor X. Nguyen	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-71 is/are pending in the application.
- 4a) Of the above claim(s) 36,45,51,61 and 67-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34,37-41,43,46-50,52-53,55-60,62-63 and 65-66 is/are rejected.
- 7) ☒ Claim(s) 35,44,54 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/03,06/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims 36,45,51,61 and 67-71 drawn to non-elected inventions. In 6/23/2005, applicant elected to prosecute Group I, Specie 1 that associated with figures 1-4. Furthermore, applicant has stated that Species I should include figures 5a-5c and 7-8. The examiner agrees with the applicant that the election requirement has shifted so that Species I includes figures 5a-5c and 7-8 for the purposes of examination. Therefore, non-elected claims 36,45,51,54,61 and 67-71 are withdrawn from further consideration.

The requirement is deemed proper and is therefore made **Final**.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34,37,39,41,43,46,48,50,52,53,55-56,58,60,62-63 and 65-66 are rejected under 35 U.S.C. 102 (b) as being anticipated by Rosenbluth et al (U.S.5,007,898).

Rosenbluth et al show a tissue dissector (figures1, 11-12) having the limitations as recited in the above listed claims, including: an elongated cannula (18), a distal tip (58) has a tapered outer walls converting to a blunt end, a locking mechanism (106) positioned on the cannula proximal to the distal tip, a dilating element (62) disposes on the cannula, where the dilating

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element has a cross sectional dimension greater than the cross sectional dimension of the distal tip, where the dilating element further has a mating lock (fig. 1, element 28) which is capable for removably positioning the dilating element on the cannula, and where the device further has an endoscope (20) sized to fit within a lumen of the cannula, and the distal tip is capable of being dissected with the endoscope, where the dilating element (62) is an oval shape, and where the cross sectional dimension of the dilating element can be two times larger than the cross sectional dimension of the distal end of the cannula (fig. 1), where the dilating element can be compressible.

Claims 34,37,43,46,52,56,63 and 66 are rejected under 35 U.S.C. 102 (e) as being anticipated by Chin (U.S.5,980,549).

Chin discloses a tissue dissector (figures 1,8a-b) having the limitations as recited in the above listed claims, including: an elongated cannula (800), a distal tip (803) has a tapered outer walls converting to a blunt end, a locking mechanism (see col. 9, lines 65-66, and col. 10, lines 1-4) positioned on the cannula proximal to the distal tip, a dilating element (124) disposes on the cannula, where the dilating element has a cross sectional dimension greater than the cross sectional dimension of the distal tip, where the dilating element further has a mating lock (fig. 1), which is capable for removably positioning the dilating element on the cannula,, and where the device further has an endoscope (110) sized to fit within a lumen of the cannula, where the distal tip is transparent to allow tissue being dissected to be visualized with the endoscope through the distal tip.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38,40,47,49,57 and 59 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rosenbluth et al (5,007,898).

Rosenbluth et al disclose the invention substantially as recited in the claims, but Rosenbluth does not disclose a spacer length of cannula of between 14-28 mm disposed between a distal end of a dilating element which has dimension between 15-30 mm and a proximal end of the distal tip. It would have been obvious matter of design choice to modify the device that has a spacer length of cannula of between 14-28 mm disposed between a distal end of a dilating element which has dimension between 15-30 mm and a proximal end of the distal tip, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re.Aller, 220F, 2d 454, 105 USPQ 233.

Allowable Subject Matter

4. Claims 35,44,54 an 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest all of the limitations of the above listed claims including, the locking mechanism comprises a length of screw threads

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positioned on the outer surface of the cannula, where the mating lock comprises a threaded bore hole formed in the dilating element for engaging the length of screw threads.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

5. Applicant's arguments filed 2/22/2005 and 6/23/2005 have been fully considered but they are not persuasive. Applicant is asked to please refer to the modified prior art rejection above where examiner addresses applicant's concerns regarding prior art rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn *VN*
9/2/2005

Julian W. Woo

**JULIAN W. WOO
PRIMARY EXAMINER**